

Notice of Allowability

Application No.

10/063,907

Examiner

Fred Ferris

Applicant(s)

PHILLIPS ET AL.

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 28 March 2007.
2. ☒ The allowed claim(s) is/are 1, 3-25 (Now renumbered as 1-24).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 6/5/02
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


FRED FERRIS
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

DETAILED ACTION

1. *This office action is responsive to applicant's amendment filed on 28 March 2007. Applicants have cancelled claim 2. Claims 1 and 3-25 are currently pending in this application and have now been allowed over the prior art of record.*

Response to Arguments

2. *Applicant's arguments filed 28 March 2007 have been fully considered and are persuasive.*

Regarding applicants' response to 112(1) rejections: *The examiner withdraws to 112(1) rejection in view of applicants' amendment to the claims and supporting arguments filed 28 March 2007.*

Regarding applicants' response to 103(a) rejections: *The examiner withdraws to 103(a) rejection in view of applicants' amendment to the claims and supporting arguments filed 28 March 2007.*

Allowable Subject Matter

3. *Claims 1 and 3-25 are allowed over the prior art of record.*

The following is an examiner's statement of reasons for allowance:

Applicants are disclosing a method, system, and computer code for designing, tracking, and locating a chemical design consisting of a chemical backbone structure and attachment points for chemical substituents in creating a custom chemical design structure. This has been disclosed in the prior art of record.

While these elements are individually disclosed in the prior art, the prior art of record does not meet the conditions as suggested in MPEP section 2132, namely:

*"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an **ipsissimis verbis** test, i.e., identity of terminology is not required. **In re Bond**, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."*

In particular, the prior art does not disclose the specific sequence of steps or arrangement of system elements that further includes the elements noted above in combination with the additional elements relating to the chemical backbone structures being associated with a corresponding substituent menu containing substituents selectable by a user for attachment to pre-specified attachment points of the chemical backbone structure such that a custom chemical design structure is specified, as now required by amended independent claims 1, 15, 18, 20 -23, and 25.

The closest prior art uncovered during examination teaches certain limitations of the claimed invention as follows:

- US Patent Application Publication 2002/0129004: Bassett discloses an interactive Wizard based chemical design query tool inclusive of a user interface with database for guiding the user in chemical selection, transmitting responses, tacking quires, and providing a welcome screen and submitting a chemical selection to a provider (vendor) system. However, Bassett does not explicitly disclose the additional combination

of elements relating to the chemical backbone structures being associated with a corresponding substituent menu containing substituents selectable by a user for attachment to pre-specified attachment points of the chemical backbone structure such that a custom chemical design structure is specified, as now required by amended independent claims 1, 15, 18, 20 -23, and 25.

- "ADC/Chem Sketch", Version 5.0 Users Guide: ChemSketch discloses a commercially available chemical structure drawing software package inclusive of features for designing a graphical representation of a chemical design structure ChemSketch further teaches a software tool allowing a user to create (specify) a graphical representation of custom chemical structures (backbone/substituent, etc.) inclusive of features for selecting chemical structures that are custom designed by a user, creating text windows for specifying custom chemical design parameters, and defining attachment points (receptors) for to the chemical design structure. However, Chems sketch again does not explicitly disclose the additional combination of elements relating to the chemical backbone structures being associated with a corresponding substituent menu containing substituents selectable by a user for attachment to pre-specified attachment points of the chemical backbone structure such that a custom chemical design structure is specified, as now required by amended independent claims 1, 15, 18, 20 -23, and 25.


The features noted above therefore render the claimed invention non-obvious over the prior art of record. Dependent claims 3-14, 16, 17, 19, and 24 are deemed allowable as depending either directly or indirectly from independent claims 1, 15, 18, 18, 20-23, and 25.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

4. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Ferris whose telephone number is 571-272-3778 and whose normal working hours are 8:30am to 5:00pm Monday to Friday. Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist whose telephone number is 571-272-3700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached at 571-272-2279. The Official Fax Number is: (571) 273 8300*

*Fred Ferris, Primary Examiner
Simulation and Emulation, Art Unit 2128
U.S. Patent and Trademark Office
Randolph Building, Room 5D19
401 Dulany Street
Alexandria, VA 22313
Phone: (571-272-3778)
Fred.Ferris@uspto.gov
April 18, 2007*


FRED FERRIS
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100